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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,410	01/23/2002	Michael Van Abel	P/73-6	1619

7590 07/29/2003

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EXAMINER	
PICKETT, JOHN G	
ART UNIT	**PAPER NUMBER**
3728	4

DATE MAILED: 07/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)	
	10/057,410	ABEL ET AL.	
	Examiner	Art Unit	
	Gregory Pickett	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 July 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9* is/are pending in the application.

4a) Of the above claim(s) *9* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *9* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *23 January 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Species 1 in Paper No. 3 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim 9 is withdrawn from further consideration as being directed to a non-elected species.

Information Disclosure Statement

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Chaperot et al (EP 0 831 032 A1).

Regarding claim 1, Chaperot et al discloses a ream wrap (figure 1) comprising a paper poly coated composite (1) having transparent, solid plastic film windows (3, 4, 9, 10).

As to claim 4, the windows of Chaperot et al allow viewing (as shown, Figure 3) of multiple sheets of paper (13).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chaperot et al.

Regarding claim 2, Chaperot et al discloses the claimed invention except for the various shapes and sizes of the windows. Chaperot et al discloses the functional purpose of the windows in the display of the edges of the paper ream (see Figure 3). It therefore appears to the examiner that the applicant is merely using the various shapes and sizes for ornamental purposes. As such, a change in aesthetic (ornamental) design generally will not support patentability. In re Seid, 73 USPQ 431. Further, a change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

As to claim 3, Chaperot et al discloses the claimed invention except for the various locations of the windows. Chaperot et al discloses the functional purpose of the windows in the display of the edges of the paper ream (see Figure 3). It therefore appears to the examiner that the applicant is merely using the various locations for ornamental purposes. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the windows in various locations, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

5. Claims 5, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chaperot et al in view of Broeren (US 2,025,969)

Regarding claim 7, Chaperot et al discloses a ream wrap (figure 1) comprising a first layer of paper (1), a second layer of transparent film (9,10), and holes (3,4) covered by film layers (9, 10). Chaperot et al discloses the functional purpose of the windows in

the display of the edges of the paper ream (see Figure 3). It therefore appears to the examiner that the applicant is merely using the various locations for ornamental purposes. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the windows in various locations, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

Chaperot et al does not expressly disclose an adhesive between the first and second layers.

Broeren discloses a wrap for sheet material with a transparent film (20) held in place with an adhesive (see Col. 1, ll. 48-55). It would have been obvious to one of ordinary skill in the art at the time the invention was made to secure the film of Chaperot et al to the paper layer using adhesive as taught by Broeren in order to prevent the film from moving during assembly and transportation.

As to claims 5 and 6, the ream wrap of Chaperot-Broeren meets the claimed methods by presentation.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chaperot et al in view of Broeren as applied to claim 7 above, and further in view of Wittosch et al (US 5,989,724).

The ream wrap of Chaperot-Broeren discloses the claimed invention except for the specific basis weight of the paper.

Wittosch et al discloses a ream wrap with a paper basis weight in the range claimed by the applicant (see for example, Col. 3, ll. 34-36). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the paper layer of Chaperot-Broeren in a weight range as taught by Wittosch et al I order to ensure wrap integrity during transport and handling. The examiner notes that the paper weight ranges claimed by the applicant are common and conventional in the ream wrap art.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Casanova et al discloses a wrap for sheet material with a window in an alternate location.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 703-305-8321. The examiner can normally be reached on Mon-Fri, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

GP

Gregory Pickett
Examiner
July 16, 2003

Mickey Yu
Supervisory Patent Examiner
Group 3700